



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-----------------------|---------------------|------------------|
| 09/825,707 | 04/04/2001 | Simon Peter Valentine | 01-394 | 3102 |

7590 03/08/2006

McDonnell Boehnen Hulbert & Berghoff
32nd Floor
300 S. Wacker Drive
Chicago, IL 60606

EXAMINER

EL CHANTI, HUSSEIN A

ART UNIT PAPER NUMBER

2157

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/825,707

Applicant(s)

VALENTINE ET AL.

Examiner

Hussein A. El-chanti

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-18 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) 21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-18, 21 and 23-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. This action is responsive to RCE received on Jan. 13, 2006. Claims 21-25 were newly added.
2. Newly submitted claims 21 and 22 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:
 - I. Claims 1-10 and 12-20, 23-25, drawn to computer network managing, classified in class 709, subclass 223.
 - II. Claims 21 and 22, drawn to computer data addressing, classified in class 709, subclass 245.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because invention I does not require determining two MAC address associated with a port where one of the MAC addresses is associated with the phone. The subcombination has separate utility such as invention II determines two MAC addresses associated with the same port where one of the MAC addresses is associated with the phone and determining two MAC address are not associated with the phone.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 21 and 22 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 6-10 and 25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 6-10 and 25 recite nothing but the physical characteristics of a form of energy, such as a signal, frequency, voltage, or the strength of a magnetic field, define energy or magnetism, *per se*, and as such are nonstatutory natural phenomena.

O'Reilly v. Morse, 56 U.S. (15 How.) 62, 112 – 14 (1853). See MPEP 2106 IV.B.1. c. A claimed signal has no physical structure, does not itself perform any useful, concrete and tangible result and, thus, does not fit within the definition of a machine.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 2157

4. Claims 4, 5, 7, 9, 16 and 23-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 24 states "the first given protocol is HTML". However, it is well known in the art that HTML is a hypertext document format used on the world wide web and not a "protocol".
6. Claims 4 and 9 recite the limitation "the telephone" in the claim. There is insufficient antecedent basis for this limitation in the claim.
7. Claims 5 and 16 recite the limitation "the phone icon" in the claim. There is insufficient antecedent basis for this limitation in the claim.
8. Claim 7 recites the limitation "the second protocol" in the claim. There is insufficient antecedent basis for this limitation in the claim.
9. Claims 23 and 25 recite the limitation "it is attached to the same port" in the claim. There is insufficient antecedent basis for this limitation in the claim.
10. Claim 23 recites the limitation "the device" in the claim. There is insufficient antecedent basis for this limitation in the claim.
11. Claim 25 recites the limitation "telephone" in the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2157

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1, 3-6, 8-10 and 12, 14-18, 23 and 25 are rejected under 35

U.S.C. 102(e) as being anticipated by Kracht, U.S. Patent No. 6,516,345.

Kracht teaches the invention explicitly as claimed including a system and method for determining a set of network addresses for identifying a network devices (see abstract).

As to claim 1, Kracht teaches a method of discovery and display of one or more phones on a network, said method including the steps of

discovering a phone by means of a first protocol (see col. 6 lines 51-col. 7 lines 5 and col. 18 lines 53-67) ,

using discovered information to insert an icon representing the phone in the relevant position in a display of the topology of the network (see col. 6 lines 51-col. 7 lines 5), and

discovering other devices on the network using a different protocol (see col. 7 lines 20-30).

As to claim 3, Kracht teaches a method as claimed in claim 1 in which the display comprises a map of the network (see fig. 8 and its corresponding illustration).

As to claim 4, Kracht teaches a method as claimed in claim 3 in which, on the map, the icon phone is connected to the other parts of the network by a line which represents the line connecting the telephone to the network (see fig. 8 and its corresponding illustration).

As to claim 5, Kracht teaches a method as claimed in claim 1 in which the display includes, adjacent said phone icon, further information relating to the phone (see col. 14 lines 40-67).

As to claims 6, 23 and 25, Kracht teaches a computer program on a computer readable medium or embodied in a carrier wave for use in discovery and display of one or more phones on a network, said computer program comprising: a program step for establishing the topology of the network including said one or more phones, said program step comprising a program step for establishing the topology of the network using a first protocol, and a program step for establishing the topology of said one or more phones using a different protocol, and a program step for using this information to insert an icon representing a relevant phone into a display of the topology of the network (see col. 6-col. 7).

As to claim 8, Kracht teaches a computer program as claimed in claim 6 including a program step for providing the topology in a form which may be displayed on a visual display unit as a map of the network (see fig. 8 and its corresponding illustration).

As to claim 9, Kracht teaches a computer program as claimed in claim 6 including a program step whereby on the map, the icon is connected to other parts of the network by a line which represents the line connecting the telephone to the network (see fig. 8 and its corresponding illustration).

As to claim 10, Kracht teaches a computer program as claimed in claim 6 including a program step for establishing further information relating to the phone, and a program step for providing said information in a form whereby this information may be displayed on the visual display unit (see col. 14 lines 40-67).

As to claim 12, Kracht teaches apparatus for use in the discovery of one or more phones on a network, comprising means to discover the network, including means to discover one or more phones and the other devices on the network using different protocols and means to use the information discovered to insert an icon representing a phone in the relevant position in a display of the topology of the network (see fig. 8 and its corresponding illustration).

As to claim 14, Kracht teaches apparatus as claimed in claim 12 in which the display comprises a map of the network (see fig. 8 and its corresponding illustration).

As to claim 15, Kracht teaches apparatus as claimed in claim 14 in which, on the map, the icon is connected to the other parts of the network by a line which represents the line connecting the telephone to the network (see fig. 8 and its corresponding illustration).

As to claim 16, Kracht teaches apparatus as claimed in claim 12 in which the display includes, adjacent said phone icon, further information relating to the phone (see col. 6 lines 51-col. 7 lines 5 and lines 20-30).

As to claim 17, Kracht teaches a method as claimed in claim 1 in which discovering a Phone by means of a first protocol comprises obtaining from the network an address of the phone using a first given protocol; and

responsive to obtaining the address obtaining from the network the identity of the phone using a second given protocol (see col. 6 lines 51-col. 7 lines 30).

As to claim 18, Kracht teaches a method as claimed in claim 17 further comprising obtaining from the network details associated with the phone using the second given protocol (see col. 6 lines 51-col. 7 lines 30).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 13.** Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kracht.

Kracht teaches a system and method for discovering a loading a page and parsing information from the webpage to establish correspondence between a phone and a MAC address (see col. 6 lines 45-col. 7 lines 30). However Kracht does not explicitly teach the page is a webpage. It would have been obvious for one of the

Art Unit: 2157

ordinary skill in the art at the time of the invention to load the Kracht's page as a webpage on the world wide web because doing so would allow the user to view the page from virtually any location with access to the internet and therefore overcome the need to have the specialized software or page loaded or stored on a single machine.

14. Claims 2, 7, 13 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kracht.

Kracht teaches a system and method for discovering a devices on a network using a discovery protocol (see col. 6 lines 45-col. 7 lines 30). However Kracht does not explicitly teach the protocol is HTTP protocol. It would have been obvious for one of the ordinary skill in the art at the time of the invention to use HTTP to discover devices as taught by Kracht because doing so would enable the system more efficient by using a protocol that is universally used and overcoming compatibility problems as evident by Microsoft Computer Dictionary 5th Edition.

Response to Arguments

15. Applicant is arguing Kracht does not disclose Ethernet phones. This limitation are not found in the claims. Claimed subject matter not the specification is the measure of the invention. Disclosure contained in the specification cannot be read into the claims for the purpose of avoiding prior art. In re Sporck, 55 CCPA 743, 386 F.2d 924, 155 USPQ 687 (1986); In re Self, 213 USPQ 1, 5 (CCPA 1982); In re Priest, 199 USPQ 11, 15 (CCPA 1978). Kracht teaches discovering phones and the devices connected to the network using the phone lines.

Art Unit: 2157

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hussein A. El-chanti whose telephone number is (571)272-3999. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hussein El-chanti

March 1, 2006


ARIO ETIENNE
PRIMARY EXAMINER